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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Heidrick & Struggles International Inc.

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Serial No. 76/207,231

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Lewis T. Steadman, Jr. of Holland & Knight, L.L.P. for Heidrick & Struggles International, Inc.

Hannah Fisher, Trademark Examining Attorney, Law Office 111 (Craig Taylor, Managing Attorney).

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Before Cissel, Seeherman and Bottorff, Administrative Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On February 9, 2001, applicant, a Delaware corporation, filed the above-referenced application to register the mark "LEADERSHIP OPUS" on the Principal Register for "executive recruitment services," in Class 35. The basis for filing the application was applicant's assertion that it possessed a bona fide intention to use the mark in commerce in connection with these services.

The Examining Attorney refused registration under Section 2(d) of the Lanham Act, 15 U.S.C. Section 1052(d), on the ground that the mark so resembles "OPUS INTERNATIONAL, INC.," which is registered[1] for "executive employment recruitment services in the field of [the] food industry," that if applicant were to use the mark it seeks to register in connection with the services specified in the application, confusion would be likely.

Applicant responded to the refusal to register with argument that confusion would not be likely because "[t]he marks are clearly different and distinguishable on their face" (sic); the common word in both marks, "Opus," "is not uncommon" in registered trademarks (a list of four third-party registered marks which include the word "Opus" was provided); and the trade channels in which registrant renders its service are different from those in which applicant intends to use its mark.

The Examining Attorney was not persuaded by applicant's arguments, and in her second Office Action, she made the refusal to register under Section 2(d) final. Noting that third-party registrations, by themselves, are

[1] Reg. No. 2,417,602 issued on the Principal Register to Opus International, Inc., a Florida corporation, on January 2, 2001. The term "INTERNATIONAL, INC." is disclaimed apart from the mark as shown.

entitled to little weight on the question of likelihood of confusion, she concluded that the third-party marks applicant had listed are for goods and services in industries which are different from the executive recruitment industry.

Applicant requested reconsideration. The request included a list of thirty third-party registrations of marks that consist of or include the word "opus." None of the products or services specified in these registrations, however, appears to be even remotely related to the recruitment of executives. Included are such goods and services as face shields for hairspray, real estate, construction and architectural services, medical apparatus, clothing, computer programs, health care publications, educational services relating to religious instruction, landscape gardening, printing paper, musical sound recordings, neckties, bird feeders, tobacco and hydrocephalic catheters.

Applicant's request for reconsideration was timely followed by a Notice of Appeal. Accordingly, the Trademark Trial and Appeal Board instituted the appeal, but suspended action on it and remanded the application to the Examining Attorney for action on applicant's request for reconsideration. The Examining Attorney noted that

applicant had not submitted official or electronic copies of the third-party registrations it listed in its request for reconsideration, but went on to state that even if proper copies had been submitted, such registrations would not be persuasive of applicant's contention that confusion would not be likely because applicant and the owner of the cited registrations both provide essentially identical executive recruitment services, whereas the third-party registrations listed by applicant are for a wide variety of goods and services, all of which are unrelated to applicant's services. The final refusal to register applicant's mark under Section 2(d) of the Lanham Act was maintained.

Action on the appeal was resumed; applicant filed its appeal brief; the Examining Attorney filed her brief; and applicant filed a reply brief. Applicant did not request an oral hearing before the Board.

The issue before us in this appeal is whether confusion would be likely to result from applicant's use of "LEADERSHIP OPUS" in connection with executive recruitment services in view of the registered mark, "OPUS INTERNATIONAL, INC." for executive employment recruitment services in the food industry field.

The factors to be considered in determining whether confusion would be likely were set forth by the predecessor to our primary reviewing court in the case of E. I. duPont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Chief among these factors are the similarity of the marks as to appearance, pronunciation, meaning and commercial impression and the relationship between the services with which the marks are, or are intended to be, used. Under certain circumstances, a portion of a mark consisting of separate elements can be more significant in creating the commercial impression that the mark engenders than other, less prominent elements. In re National Data Corp., 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1988).

When the facts presented by the instant appeal are considered in light of these principles, we find that confusion would be likely because the services specified in the cited registration are encompassed within the recitation of services in the application, and the marks create very similar commercial impressions.

Our determination of whether the services of applicant and the owner of the cited registration are so closely related that confusion would be likely must be made based upon the specific ways that the services are identified in the application and in the cited registration,

respectively, without limitations or restrictions that are not reflected therein. Otocom Systems, Inc. v. Houston Computer Services Inc., 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1982). As noted above, applicant identifies the services with which it intends to use the mark "LEADERSHIP OPUS" as "executive recruitment services." The services identified in the cited registration are "executive employment recruitment services in the field of [the] food industry." Because the latter are encompassed within the former, for purposes of our resolution of this appeal, applicant's services are legally the same as the services set forth in the cited registration. "When marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines." Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

Turning, then, to consideration of the similarity of the marks, we note that the dominant element in the cited registration is the word "OPUS." The descriptive, disclaimed terminology "INTERNATIONAL, INC." has little, if any, source-identifying significance. Applicant's mark consists of the combination of the word "LEADERSHIP," which is suggestive in connection with the recruitment of

executives, whether they provide leadership in the food industry or elsewhere, and the word “OPUS,” which is, as noted above, the dominant element in the registered mark. As applicant points out, “OPUS” is a noun meaning “work.” Because the word is usually used in connection with specific works, like paintings or musical compositions, there is a double entendre with the ordinary meaning of “work,” as in employment, which makes the term somewhat suggestive in connection with the services set forth in the application and the cited registration. This suggestiveness, however, is the same in connection with applicant’s services as it is in connection with the services for which the cited mark is registered, so the similarity between these marks is only amplified by virtue of the inclusion of “OPUS” in both marks. Contrary to applicant’s arguments, when these two marks are considered in their entireties, they create similar commercial impressions. Applicant’s mark appropriates the dominant portion of the registered mark and combines it with a suggestive word that does not sufficiently distinguish the two marks.

Applicant’s arguments with regard to the third-party registrations of marks which consist of or include “OPUS” are not well taken. As the Examining Attorney correctly

points out, copies of these registrations were never submitted, and merely listing them did not make them of record. The Examining Attorney presented arguments based on these registrations only after pointing out that they were not of record. Accordingly, her objection to the lists applicant provided is well taken, and we have not considered these registrations. In any event, even if copies of these registrations had been made of record properly, they would not have supported applicant's argument that the cited registered mark is weak by virtue of extensive use by others. Third-party registrations are not evidence of use of the marks therein, and, as noted above, none of the listed third-party registered marks is for services or goods which are the same as or even related to the services at issue in this appeal. Further, many of the marks listed by applicant, e.g., "MAGNUM OPUS," "OPUS MILLENNIUM STORE SYSTEM," "OPUS MEDIA" and "OPUS FROMUS," are easily distinguishable from the two marks at issue in this appeal.

Considered in their entireties, applicant's mark and the cited registered mark are similar, and if they were used in connection with the same services, confusion would be likely. A personnel officer, for example, who is familiar with "OPUS INTERNATIONAL, INC." in connection with

executive recruitment services in the food industry, upon subsequently encountering “LEADERSHIP OPUS” in connection with the same services, would be likely to assume, mistakenly, that one entity is responsible for the services rendered under both marks. This is exactly the type of confusion to which Section 2(d) of the Lanham Act is directed.

Even if there remained any doubt as to whether confusion would be likely, any such doubt we might have would have to be resolved in favor of the registrant, not the applicant. Applicant, as the second comer, has a duty to select a mark which is not likely to cause confusion with another mark already in use in the marketplace for the same services. In re Hyper Shoppes (Ohio), Inc., 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir., 1988).

DECISION: The refusal to register under Section 2(d) of the Lanham Act is affirmed.